

REMARKS

I. STATUS OF CLAIMS AND AMENDMENTS

In this Amendment, minor amendments have been made to independent claim 70 for clarity. Claims 70 to 79 are pending and under examination.

A substitute Table 5 is being filed herewith. The substitute Table 5 (including Tables 5A-5WWW) contains a column for SEQ ID NO, to better integrate the information with Table 1.

No new matter has been introduced. Further, since the amendments to independent claim 79 are minor, and do not impact the scope of the claim, consideration of this Amendment after final is appropriate and is respectfully requested.

II. RESPONSE TO REJECTION UNDER 35 USC §112, FIRST PARAGRAPH

At pages 3-6 of the Office Action, claims 70-79 are rejected under 35 USC §112, First Paragraph, as allegedly not being sufficiently enabled by the specification.

Specifically, the Office Action raises the following issues as being allegedly relevant to enabling the present claims:

- (1) The specification does not disclose steps necessary for the comparison of experimental expression levels and statistical values from the database;
- (2) Tables 5A-5WWW are lengthy and list genes by GLGC ID, and not SEQ ID NO. as in Table 1;
- (3) Some genes listed in the Table are ESTs.

This rejection is respectfully traversed.

It is noted that the rejection is largely taken verbatim from the Final Office Action dated February 5, 2007 in Application No. 10/357,507, now US Patent 7,469,185, which discloses related subject matter and is commonly owned. The Examiner's attention is also respectfully directed to the fact that these rejections were withdrawn in Application No. 10/357,507 on the basis of the claim language already present in this application. While the Applicant understands that the now issued patent was examined by a different examiner, it is believed that, to the extent possible, the standard of enablement should be applied consistently by the Patent Office, especially to such similar facts.

For example, instant claim 70 already recites "normalized" expression values, and recites a statistical expression of the model data that would facilitate its comparison with test data. Methods of comparing gene expression information is described in the application at paragraphs [0203] and [0204], for example.

With respect to the Examiner's distinction between genes and ESTs, it is the Applicant's position that such does not impact the enablement of the claimed method. Indeed, this rejection was ultimately withdrawn in Application No. 10/357,507 without amendment on the Applicant's part.

Finally, Applicants understand that the Tables are lengthy, and thus an amended Table 5 is submitted herewith providing corresponding SEQ ID NOS, to better integrate Table 5 with Table 1.

Withdrawal of this rejection is respectfully requested.

III. RESPONSE TO REJECTION UNDER 35 USC §112, SECOND PARAGRAPH

At pages 6 and 7 of the Office Action, claims 70-79 are rejected under 35 USC §112, second paragraph.

(1) Specifically, the Examiner asserts that the language “differential gene expression levels for said at least 10 genes upon exposure to the test compound” is unclear.

This rejection is respectfully traversed, because the language of claim 70 is sufficiently clear on its face. The language “differential gene expression levels for said at least 10 genes *upon exposure to the test compound*,” clearly indicates that the test compound is inducing the “differential” gene expression (e.g., as opposed to when the compound is not present).

(2) The Examiner asserts that there is no antecedent basis for “the” normalized mean expression levels” in claim 70.

The antecedent “the” has been removed.

Withdrawal of these rejections is respectfully requested.

III. PROVISIONAL OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTIONS

At pages 8-18 of the Office Action, the Examiner rejects the claims as being obvious over one or more claims of Application Nos. 11/059,535; 10/515,373; 11/547,759; 12/043,666; 12/181,020; and 12/256,225.

The Issue Fee for Application No. 11/059,535 has been paid. Thus, a Terminal Disclaimer with respect to this co-pending application is being submitted herewith.

As for the remaining provisional obviousness-type double patenting rejections, The Examiner’s attention is respectfully directed to MPEP §804(I)(B):

If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.

Thus, upon withdrawal of the Section 112 rejections (which is respectfully requested), the obviousness-type double patenting rejection over applications numbers 10/515,373; 11/547,759; 12/043,666; 12/181,020; and 12/256,225 should also be withdrawn.

IV. CONCLUSION

In view of the foregoing, this Application is believed to be in condition for allowance. However, the Examiner is invited to call the undersigned if any questions or comments arise that would be appropriately addressed in a telephonic or personal interview.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1283.

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